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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,592	06/15/2006	James A Faunce	14154US02	3761
7590	06/16/2009		EXAMINER	
McAndrews Held & Malloy 500 W Madison St 34th Floor Chicago, IL 60661				CAMPANELL, FRANCIS C
ART UNIT		PAPER NUMBER		
		1797		
		MAIL DATE		DELIVERY MODE
		06/16/2009		PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/538,592	FAUNCE, JAMES A	
	<b>Examiner</b>	<b>Art Unit</b>	
	FRANK C. CAMPANELL	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 June 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/25/2007</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by Rieder (US 4172802).

3. Regarding claims 1-10, Rieder teaches a method of making a water-based lubricant (column 1 lines 15-30). The lubricant is 2 to 20% a phthalate ester (column 8 lines 16-24) and 60 to 93% water. (the remainder of the weight is water after the 2 to 20% phthalate ester, also see examples 1-12 in columns 9-10)

4. The phthalate ester is made from reacting a phthalic (see column 5 lines 5-20) anhydride (column 5 lines 50-55) with an alcohol. The alcohol is a polyol having the formula of matching the Markush structure of claim 1 subsets (2) (A) and (2) (B) of the instant application. See column 4 lines 7-35 of Rieder.

5. The resulting compound is then reacted with an alkoxylating agent to produce a phthalate ester reaction product having at least one terminal hydroxyl group. (see column 4 lines 7-15 for the terminal hydroxyl group) This second reaction stems from the alkoxylating agent polymerization with the alkoxylating agent. See column 6 lines 1-25.

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6. The resulting lubricant is mixed with at least one other desirable ingredient. (see column 8 lines 9-15)
7. The lubricant is used in metal working. (column 1 lines 8-10)

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US 4383937).

11. Regarding claims 5-10, Williams teaches a method of making a water-based lubricant for use in metal working (column 1 lines 15-30). The lubricant is 2 to 20% a phthalate ester (column 22 examples 56-57) and 60 to 93% water.

12. The phthalate ester is made from reacting a phthalic (column 9 line 15-55) anhydride (column 3 lines 40-60) with an alcohol. The alcohol has the formula of

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matching the Markush structure of claim 1 subsets (1) and (2) (A) and (2) (B) of the instant application. See column 9 lines 59-column 10 line 6 of Williams. The resulting product has a terminal hydroxyl group (namely the terminal OH on the aromatic ring carboxylic acid).

13. Williams does not state a further reaction of the resulting phthalic ester with an alkoxylating agent. It is the assertion of the examiner that such a final product as stemming from this final reaction is already present in the final product, and hence the actual lubricant is taught by Williams. See table II column 17-18 for final products produced in the invention of Williams. It would have been obvious to one of ordinary skill in the art that such a lubricant additive product is presented in the variety of possible products outlined by Williams.

14. The resulting lubricant is mixed with at least one other desirable ingredient. (column 22 examples 56-57)

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK C. CAMPANELL whose telephone number is (571)270-3165. The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FCC

/Walter D. Griffin/  
Supervisory Patent Examiner, Art Unit 1797